

REMARKS

This is a full and timely response to the non-final Office action mailed January 23, 2008. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

Present Status of Patent Application

Upon entry of the amendments in this response, claims 1-13, 16, 18-20, and 23-27 are pending in the present application. More specifically, claims 2 and 10 are original claims; claims 3-9, 11, 12, 16, and 18-20 are previously presented claims; claims 1 and 13 have been currently amended without introduction of new matter; claims 23-27 are new claims that are being submitted without introduction of new matter; and claims 14, 15, 17, 21 and 22 are currently canceled without prejudice, waiver, or disclaimer. Applicants reserve the right to pursue the subject matter of the cancelled claims in a continuing application if they so choose, and do not intend to dedicate the subject matter of the cancelled claims to the public.

Reconsideration and allowance of the application and presently pending claims are respectfully requested.

A. Indication of allowability

Applicants express their gratitude towards Examiner for indicating that claim 22 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In accordance with this indication, Applicants submit herein, amended claim 1 (base claim) that includes all of the limitations cited in dependent claims 21 and 22, which have been currently canceled. Consequently, as a result of this amendment, Applicants respectfully request allowance of claim 1 and all its dependent pending claims.

B. Claim Rejections under 35 U.S.C. §103

Statement of the Rejection

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boston et al. (Hereafter, Boston) U.S. Patent 5,757,680 in view of Ross et al. (Hereafter, Ross) U.S. Patent 5,247,517.

Response to the Rejection

Claim 1

As pointed out above, Applicants have currently amended claim 1 to include all limitations from claims 21 and 22. Consequently, as a result of this amendment, Applicants respectfully request allowance of claim 1.

Claims 2-12

Applicants respectfully traverse the rejection of claims 2-12 that are allowable for several reasons. However, rather than providing a detail explanation for the traversal at this stage of prosecution, Applicants instead opt to assert that because claim 1 is allowable, claims 2-12 that depend directly or indirectly on claim 1 are also allowable as a matter of law. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Consequently, for at least this reason, Applicants respectfully request allowance of claims 2-12.

Claim 13

Applicants request withdrawal of a remark made in an earlier response wherein Applicants had asserted in pertinent part, that “*claim 13 recites elements that essentially track the pertinent elements of claim 1.*” Applicants’ assertion was erroneous because it is improper to link the scope of an apparatus claim to that of a method claim. While the method steps recited in claim 13 may cite certain elements from apparatus claim 1, it should be understood that the scope and limitations inherent to each of these two claims is independent of one another. For example, as currently amended, claim 1 includes a transceiver that is not pertinent to claim 13.

Turning to the current amendment of claim 13, attention is drawn to Applicants’ original specification and specifically to the background section wherein Applicants have described the need for a universal, self-adaptive communications module that may be plugged into a variety of host systems for enabling each individual host system to be automatically configured for communicating with a remote network device (link partner). This aspect is referred to, in Applicants’ specification page 4, line 31 to page 5, line 3 as follows: “*In this way, a single self-configuring communications module design may be used with many different types of host systems. This feature simplifies manufacturing and marketing tasks for manufacturers of the communications module and reduces component selection complexity, incompatibility issues, and obsolescence risks for customers purchasing the communications*”

module” (emphasis added).

Applicants further disclose in page 5, lines 24-30 of their specification: “*In some implementations, the protocol handler 28 directs communications through a particular one of multiple data paths (or data channels) between the host interface port 24 and network media interface port 26 that converts signals to and from the MAC interface 18 in accordance with the identified communications protocol. In other implementations, protocol handler 28 dynamically converts signals to and from the MAC interface 18 in accordance with the identified communications protocol*” (emphasis added). As can be understood from these and other teachings in Applicants’ specification, the communications module identifies one of several alternative communications protocols that a particular host system is using and then uses this identified protocol to set up a communications path between the host system and the network device (link partner).

In contrast to Applicants’ solution, the cited prior art of Boston discloses in his Abstract section: “*an electronic device that can communicate with a plurality of testing devices that utilize a plurality of communication formats. To accommodate the plurality of testing devices, the electronic device can be configured to communicate with external test equipment using multiple communication path configurations and multiple message protocols. An exemplary method of the present invention is a method of configuring an electronic device for communicating with either of a first or second testing device” (emphasis added). As can be appreciated, Boston’s device determines the message protocol used by a particular test equipment (equivalent to Applicant’s link partner) and then based on the protocol used by its link partner (test equipment), selects a protocol among its repertoire of protocols for communicating with the particular test equipment. In this scenario, Boston’s device itself operates as a reconfigurable “host” system (i.e. there is no universal plug-in communications module that is used for determining an unknown protocol used by a host system into which the module is inserted).*

To further substantiate, attention is drawn to Boston’s Fig. 1, which shows an electronic device 10, described in his col. 3, lines 39-42 as: “*Such a device may, for example, be a cellular telephone, personal communication device, personal data assistant (“PDA”), or household applicants.*” Consequently, unlike Applicants’ claim 13 which pertains to a communications module incorporating an adaptive protocol handler that is used for identifying

a hitherto unknown communications protocol of the host system, Boston's device, in contrast, is aware of its own protocol and determines the hitherto unknown protocol used by one of several test devices (link partners) coupled to Boston's device (host system).

Turning now to a different aspect, attention is drawn to the current Office action wherein, in carrying out the rejection of claim 13 under 35 U.S.C. 103(a), it is asserted that Applicants' claim 13 *"is a method of claim 1"* and is consequently *"rejected under the same rationale as cited in the rejection of rejected claim 1."* Applicants respectfully traverse this assertion for several reasons. As one reason, Applicants draw attention to page 3, wherein the current Office action admits that *"Boston fails to teach a host interface port connectable to a media access control interface of a host system"* and then goes on to assert that *"Ross teaches a host interface port connectable to a media access control interface of a host system (e.g. Figure 1, Host I/F 35 connected to MAC 28)."*

Applicants respectfully point out that in contrast to Applicants' apparatus claim 1 which does indeed refer to a MAC interface, method claim 13 does not cite a MAC interface. Consequently, Applicants respectfully assert that the rejection of claim 13 is improper. Specifically, the cited prior art of Ross is inapplicable to Applicant's claim 13. Additionally, it may be relevant to point out that Ross' invention pertains to *"a method and apparatus for analyzing and monitoring network activity"* and has no bearing upon Applicant's method of communications as specifically cited in claim 13.

Notwithstanding the remarks above, Applicants have opted to currently amend claim 13 so as to provide focus and clarity on several aspects of the method and also to move forward prosecution in the case. Applicants respectfully submit that claim 13 is allowable over the cited prior art, more so in currently amended form, and therefore request withdrawal of the rejection followed by allowance of the claim.

Claims 16 and 18-20

Applicants respectfully submit that claims 16 and 18-20 are allowable for several reasons. One among these several reasons is due to the fact that these claims are directly or indirectly dependent on allowable claim 13 and are consequently allowable by law arising from their dependency. For at least this reason, Applicants respectfully request withdrawal of the rejection followed by allowance of claims 16 and 18-20.

Claims 14, 15, 17 and 21

Applicants have currently canceled claims 14, 15, 17, and 21 and that the rejection of these claims has been rendered moot as a result of the cancellation.

C. Remarks related to new claims

Applicants respectfully submit that new claims 23-27 are allowable over the cited prior art and hereby request consideration and allowance of these claims. The subject matter of the new claims has been disclosed in various portions of Applicants' original specification.

Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

In light of the reasons set forth above, Applicant respectfully submits that pending claims 1-13, 16, 18-20, and 23-27 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned representative at (404) 610-5689.

Respectfully submitted,

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I hereby certify that this paper is being electronically transmitted to the Commissioner for Patents on the date shown below:

Date of transmission: 11 April 2008

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